

**REMARKS**

**I. Status of Claims**

Claims 1-47 are pending and stand rejected. Without prejudice or disclaimer, claims 1 and 47 have been amended to recite that the film-forming polymer “is soluble in an organic solvent in an amount greater than 90% by weight at 25°C.” Support for this amendment may be found, for example, at paragraph [033] of the as-filed specification. Accordingly, no new matter has been added.

**II. Double Patenting Rejection**

The Examiner has provisionally rejected claims 1-47 under the judicially-created doctrine of obviousness-type double patenting over claims 1-13 and 26-53 of co-pending Application No. 10/612,920 (“the ’920 application”). Office Action at pages 2-3. The Examiner asserts that although the claims are not identical, they are not patentably distinct from each other because the claimed compositions can be the same in each application, and therefore the claimed functional limitations could be present in the other application. *Id.* at 3. Applicants respectfully traverse this rejection, but in order to advance prosecution, Applicants file herewith a Terminal Disclaimer over the ’920 application.

**III. Rejection Under 35 U.S.C. § 102**

The Examiner has rejected claims 1-47 under 35 U.S.C. § 102(e) as allegedly anticipated by U.S. Patent No. 6,113,925 (“de la Poterie”). Office Action at page 3. Applicants respectfully traverse the rejection.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” M.P.E.P.

§ 2131 (quoting *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)) (emphasis added). Further, a rejection under § 102 is proper only when the claimed subject matter is identically described or disclosed in the prior art. *In re Arkley*, 455 F.2d 586, 587 (CCPA 1972) (emphasis added). The identical invention must be described in as complete detail as is contained in, and must be arranged as required by, the claim. M.P.E.P. § 2131.

Here, the Examiner has failed to establish that each and every element in claims 1-47 of the present invention is either expressly or inherently described in *de la Poterie*. Specifically, *de la Poterie* does not expressly or inherently teach that its compositions can form “a film having a rate of mass loss of less than 0.5 mg/minute when the film is subjected to abrasion produced with a Taber abrasimeter at 23°C,” as recited in, for example, currently amended Claim 1.

The Examiner asserts that since *de la Poterie* discloses “film-forming materials such as polyurethane, acrylic, vinylic or styrene-acrylic polymers” that can be present in an amount ranging from 2% to 60%, the functional language claimed by Applicants for its composition comprising a film-forming polymer “would be inherent to the composition of *de la Poterie* as the prior art teaches the same composition.” Office Action at page 4. Applicants respectfully disagree.

In relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” M.P.E.P. § 2112(IV) (quoting *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)) (emphasis in original). Further, to establish inherency, the Examiner bears

the burden to provide extrinsic evidence, which “must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.” *Id.* (quoting *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)). “Inherency, however, may not be established by probabilities or possibilities.” *Id.*

Here, the Examiner has failed to point to any evidence to meet the requisite burden of proof in support of the inherency argument. The only “evidence” the Examiner relies on is the erroneous assertion that the film-forming polymers disclosed by *de la Poterie* are “the same” as those of the presently claimed invention. See Office Action at page 4. The Examiner’s basis for this characterization appears to be that since *de la Poterie* teaches SANCURE®, a known polyurethane, as a film former, “then it [SANCURE®] would have all the properties claimed by applicant.” *Id.* Applicants note that SANCURE® itself is not disclosed or even remotely suggested in the present specification. The Examiner then leaps to the conclusion, without any additional discussion or support, that the polyurethanes recited in the cited prior art inherently possess the properties of the film-forming polymers presently claimed, and thus compositions containing these polymers are the “same.” *Id.*

Since the Examiner bears the burden of proof to show that “the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art” as instructed in the M.P.E.P., the Examiner’s conclusion of inherent anticipation in support of the rejection cannot be based on speculation and assumption or on probabilities and possibilities. Here, without providing any further support for his argument, the Examiner can only be speculating that all compositions comprising film-forming polymers such as

polyurethanes would necessarily have the same properties as those presently claimed. Such a sweeping generalization cannot be deemed as fact without evidentiary support. The Examiner cannot provide such support because the presently claimed property of mass loss is not *necessarily* possessed by all film-forming polymers or even all polyurethanes.

In particular, the present specification notes that nail varnish compositions of the prior art “may frequently exhibit poor staying power over time.” Specification as-filed at paragraph [004]. Applicants “have discovered that a nail varnish exhibiting a low rate of mass loss during abrasion could make it possible to obtain a varnish having a good staying power over time.” *Id.* at paragraph [008]. In other words, nail varnishes (which presumably all contain some type of film-forming polymer, such as polyurethanes) do not all *necessarily* give the same results – so, lacking any scientific basis for his argument, the Examiner cannot just assert that they do.

In addition, *de la Poterie* does not teach that its compositions contain a film-forming polymer “that is soluble in an organic solvent in an amount greater than 90% by weight at 25°C,” as recited in, for example, currently amended Claim 1. The Examiner asserts that *de la Poterie* discloses “a method of forming a film, which may be used as a nail varnish comprising a film former in an aqueous medium.” Office Action at page 4. In fact, *de la Poterie* discloses that its film-forming materials must be dispersed in an aqueous medium. See *de la Poterie*, col. 2, lines 24-40; col. 4, lines 27-33; claim 1. However, film-forming materials able to be dispersed in an aqueous medium as taught by *de la Poterie* cannot meet the organic solvent solubility limitation as recited in, for example, currently amended Claim 1. This is due, in part, to the fact that the groups of

the film-forming polymer that make the polymer soluble in an amount of 90% by weight at 25°C prevent the same polymers from being dispersed in water.

The Examiner's reliance on the examples containing SANCURE® only further demonstrates the error in this rejection. SANCURE® is a polyurethane-polyester sold as an aqueous dispersion, and all of the examples in *de la Poterie* containing SANCURE® are polymers dispersed in water. See *de la Poterie*, col. 4, lines 33-37; Examples 1-4. Therefore, as *de la Poterie* teaches polymers in an aqueous dispersion, it cannot expressly or inherently teach a film-forming polymer soluble in an organic solvent in an amount greater than 90% by weight at 25°C.

Accordingly, as the Examiner has failed to establish each and every element of the rejected claims, Applicants respectfully request this rejection be withdrawn.

#### IV. Rejection Under 35 U.S.C. § 103

The Examiner has provisionally rejected claims 1-47 under 35 U.S.C. § 103(a) as being obvious over co-pending Application No. 10/612,920 ("the '920 application"). Office Action at page 5. The Examiner asserts that the '920 application would constitute prior art under 35 U.S.C. § 102(e) if published or patented since the application has a common inventor and assignee and has an "earlier effective U.S. filing date." *Id.* Applicants respectfully submit that the present application and the '920 application have the same effective U.S. filing date. Both applications were filed in the U.S. on July 7, 2003, published on April 15, 2004, and claim priority to a U.S. provisional application filed on Aug. 6, 2002, and a French patent application filed on July 8, 2002. Therefore, both applications have the same effective U.S. filing date and cannot constitute § 102(e) prior art to each other.

The Examiner asserts "this provisional rejection under 35 U.S.C. § 103(a) is based upon a presumption of future publication or patenting of the conflicting application." *Id.* Since the applications cannot constitute § 102(e) prior art, Applicants respectfully request reconsideration and withdrawal of the provisional rejection under 35 U.S.C. § 103(a).

Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

If the Examiner believes a telephone conference could be useful in resolving any of the outstanding issues, he is respectfully urged to contact Applicants' undersigned counsel at 202-408-4368.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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